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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,184	10/04/2001	Taiji Hosaka	AIA-110/DIV	2261

7590 08/17/2005

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EXAMINER
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FAROOQ, MOHAMMAD O

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/970,184

**Applicant(s)**

HOSAKA ET AL.

**Examiner**

Mohammad O. Farooq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/264,564.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/18/04; 7/14/05</u> | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on July 14, 2005 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on August 18, 2004 and July 14, 2005 was filed after the mailing date of the notice of allowance on June 15, 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

### ***Allowable Subject Matter***

3. The indicated allowability of claims 1-15 is withdrawn in view of the newly discovered reference(s) to reject claims 1-15. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao U.S. Pat. No. 5,828,905 in view of Kaneda et al. U.S. Pat. No. 5,184,282.

5. As to claim 1, Rao teaches the card connection adapter comprising:

a first connector compliant with the first standard and adapted to be electrically connected to the connector of the card slot (plurality of connectors; col. 2, lines 25-34; col. 1, lines 53-62);

a second connector compliant with the second standard (plurality of connectors; col. 2, lines 25-34; col. 1, lines 53-62);

a signal conversion circuitry connected to the first connector and the second connector for performing signal conversion between a first-standard-compliant signal and a second-standard-compliant signal (col. 1, lines 53-62; col. 2, lines 25-34 and 56-64); and

a housing which holds the first connector, the second connector and the signal conversion circuitry, the housing having a card insertion port and a card retaining space for retaining therein the second-standard-compliant card inserted from the card insertion port (col. 1, lines 63-67; col. 2, lines 25-34; col. 2, lines 56-64).

However, Rao does not teach card insertion port which opens generally perpendicularly to an adaptor insertion direction in which the card connection adaptor is inserted into the card slot. Kaneda et al. teach card insertion port which opens generally perpendicularly to an adaptor insertion direction in which the card connection adaptor is inserted into the card slot (col. 7, line 26 – col. 8, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Rao and Kaneda et al. because that would provide one or more of the IC cards in the receptor portion thereof in the electronic device (col. 1, lines 43-47).

6. As to claim 2, Rao teaches wherein the first standard is a standard which stipulates that an input/output control circuit be provided in a card to be fitted into the card slot (various types of ports; col. 2, lines 9-16).

7. As to claim 3, Rao teaches wherein the signal conversion circuitry includes the input/output control circuit for controlling input and output of the second-standard-compliant card (col. 1, lines 53-62; col. 2, lines 56-64; col. 4, lines 15-52).

8. As to claim 4, Rao teaches wherein the second standard is a standard which stipulates that an input/output control circuit be provided in the second-standard-compliant card (various types of ports; col. 2, lines 9-16).

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9. As to claim 5, Rao teaches wherein the card connection adaptor has a card shaped conformal to the first-standard-compliant card slot (col. 1, lines 53-62; col. 2, lines 56-64; col. 4, lines 15-52).

10. As to claim 6, Rao does not teach the card retaining space is closed on its rear side as seen in the adaptor insertion direction so that the second-standard-compliant card cannot be inserted or withdrawn from the rear side of the card retaining space (items 21,22 and 23, fig. 7; col. 4, lines 14-45).

Kaneda et al. teach the card retaining space is closed on its rear side as seen in the adaptor insertion direction so that the second-standard-compliant card cannot be inserted or withdrawn from the rear side of the card retaining space (items 21,22 and 23, fig. 7; col. 4, lines 14-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Rao and Kaneda et al. because that would provide one or more of the IC cards in the receptor portion thereof in the electronic device (col. 1, lines 43-47).

11. As to claim 7, Rao teaches wherein the first connector is adapted to be contact-connected to the connector of the card slot (col. 2, lines 56-64; col. 4, lines 15-52).

12. As to claim 10, Rao teaches wherein the card slot is a PC-standard memory card slot (portable memory slot; col. 4, lines 53-67).

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13. As to claim 11, Rao does not teach wherein the card retaining space is configured so as not to allow the second-standard-compliant card to project outwardly of the card retaining space when the card is retained in the card retaining space.

Kaneda et al. teach wherein the card retaining space is configured so as not to allow the second-standard-compliant card to project outwardly of the card retaining space when the card is retained in the card retaining space (items 12,22 and 23; fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Rao and Kaneda et al. because that would provide one or more of the IC cards in the receptor portion thereof in the electronic device (col. 1, lines 43-47).

14. As to claim 12, Rao teaches further comprising: a wiring board (printed circuit board) provided within the housing, on which the first connector, the second connector and the signal conversion circuitry are mounted (col. 4, lines 34-44).

15. As to claim 13, Rao teaches wherein the signal conversion circuitry includes a pin configuration conversion circuit for converting a pin configuration between a first-standard-compliant card and a second-standard-compliant card (SCSI36 pin connector; col. 4, lines 15-52).

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16. As to claim 14, Rao teaches wherein the signal conversion circuitry includes a signal processing circuit (printed circuit board) for converting signal format between the first-standard-compliant signal and the second-standard-compliant signal to ensure inter-standard compatibility (col. 4, lines 34-44).

17. As to claim 15, Rao teaches wherein the second-standard-compliant card is a memory card which incorporates therein a memory IC and has a data storage function (disks or cassettes; col. 4, lines 53-67).



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18. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao U.S. Pat. No. 5,828,905 in view of Kaneda et al. U.S. Pat. No. 5,184,282 further in view of Bhargava et al. U.S. Pat. No. 5,664,229.

19. As to claims 8 and 9, Rao teaches, the card connection adaptor, the card slot, the first connector; and second connector, second-standard-compliant card (col. 2, lines 25-34; col. 1, lines 53-62).

However, neither Rao nor Kaneda et al. teach power. Bhargava et al. teach power (col. 6, lines 52-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Rao and Kaneda et al. with Bhargava et al. because that would provide quickly and easily interconnect and disconnect an all-purpose scanning head with a selected one of a plurality of host devices each having a different data processor (col. 3, lines 7-11).

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad O. Farooq whose telephone number is (571) 272-4144. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohammad O. Farooq  
August 12, 2005

  
**KIM HUYNH**  
**PRIMARY EXAMINER**

8/18/05